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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/634,313	08/05/2003	Chihiro Tsukamoto	03-522	7879

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BACHMAN & LAPOINTE, P.C.
900 CHAPEL STREET
SUITE 1201
NEW HAVEN, CT 06510

EXAMINER

DOAN, ROBYN KIEU

ART UNIT	PAPER NUMBER
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3732

DATE MAILED: 02/09/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/634,313

Applicant(s)

TSUKAMOTO, CHIHIRO

Examiner

Robyn Doan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on 17 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☐ Claim(s) 9-15 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) 9-15 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Applicant's Amendment filed 11/17/04 has been entered and carefully considered. Claims 1-8 have been canceled. New claims 9-15 have been added. Limitations of newly added claims have not been found to be patentable over prior art of record, therefore, claims 9-15 are rejected under the same ground rejections as set forth in the office action mailed 08/17/04.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 9-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kinseley et al in view of Oivenko et al.

With regard to claims 9-15, Kinseley et al discloses a fingernail remover (figs. 1-3) comprising a receptacle (11) formed with an open end (18, fig. 1) and a closed end and a cavity defined between the opened and closed ends (col. 4, lines 3-7), the open ends inherently receive nearly second joint of a user's finger, an absorbent (17) which is impregnated with a solvent being a nail polish remover which is acetone, the absorbent being bonded to the closed end (fig. 3) of the receptacle and disposed in the receptacle

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to absorb the solvent; the absorbent also having "suitable elasticity and flexibility", the receptacle being formed of flexible and airtight material (aluminum foil col. 2, line 67) into a sack shape (a sealed envelope claim 1) for receiving a tip of the user's finger; also since the receptacle being made of aluminum foil, it cannot be dissolved or softened by the solvent. It is noted that all the claimed structures has been shown, the shown fingernail remover inherently dissolves an artificial fingernail, therefore artificial fingernail is given no patentable weight. Kinseley et al does not disclose the material of the receptacle being formed of a resin consisting of polyethylene, the material of the absorbent being formed of cloth and the resin of the receptacle having a thickness of .005mm to 1.0 mm and the length of the absorbent being shorter than the receptacle. Iovenko discloses a nail polish remover (figs. 1-4) comprising a receptacle (11) having an absorbent (12) within. The receptacle being formed by multi-layers (fig. 2) being made of polyethylene (col. 2, lines 30-32) and the absorbent being in a cylindrical shape and made of cotton woven which is cloth (col. 2, lines 68-71 and col. 3, line 1); also since the material of the receptacle being a resin and the material of the absorbent being cotton woven, therefore these materials cannot be dissolved or softened by the nail polish remover solvent. It would have been obvious to one having an ordinary skill in the art at the time the invention was made to employ the particular materials of the receptacle and the absorbent as taught by Iovenko into the device of Kinseley et al for the intended use purpose and it would have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the thickness of the receptacle being .005mm to 1.0 mm, since such a modification would have involved a

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mere change in the size of the component. And it would also have been obvious to one having an ordinary skill in the art at the time the invention was made to construct the length of the absorbent being shorter than the receptacle, since such a modification would have involved a mere change in the size of the component. It is noted that Kinseley et al has shown the closed ends of the receptacle being adhered with the absorbent, Applicant has claimed it by heat-sealing or welding which is not given any patentable weight because the claim is an article claim.

Applicant has argued that the device of Kinseley et al does not form for receiving nearly second joint of a user's finger, this is not true because Kinseley et al does not teach that the device is not capable for receiving nearly second joint of a user's finger. Also, in response to Applicant's argument that Kinseley et al includes additional structure not required by Applicant's invention, it must be noted that Kinseley et al discloses the invention as claimed. The fact that it discloses additional structure not claimed is irrelevant.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

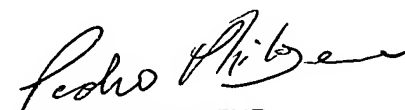
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Robyn Doan whose telephone number is (571) 272-4711. The examiner can normally be reached on Mon-Fri 9:30-7:00; alternate Mondays off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kevin Shaver can be reached on (703) 308-2582. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Robyn Doan
Examiner
February 4, 2005



PEDRO PHILOGENE
PRIMARY EXAMINER